

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **INOUE, Takakazu**

Group Art Unit: 1637

Serial No.: 10/069,977

Examiner: **Joyce Tung**

Filed: **March 13, 2002**

P.T.O. Confirmation No.: 2998

FOR: **METHOD OF ANALYZING INTESTINAL FLORA AND ANALYTICAL APPARATUS**

**PETITION UNDER 1.181 TO WITHDRAWAL FINALITY OF OFFICE ACTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Sir:

November 24, 2003

In regard to the Office Action dated **September 24, 2003**, Applicants respectfully petition  
for withdrawal of the finality of the Office action.

**REMARKS****Statement of Facts**

1. The application was filed on March 13, 2002, with 16 claims.
2. A first Office action was issued on April 10, 2003. In the Office action summary, only claims 1-14 were indicated as pending, and no mention was made of claims 15-16 in the Office action.
3. An amendment was filed on July 10, 2003. In the amendment, Applicants noted that claims 15 and 16 were pending and had not been examined, and requested examination of these claims. Claims 1-3, 10 and 11 were canceled and claims 4 and 12-14 were amended.
4. An Office action was issued on September 24, 2003, and was indicated to be final. In the Office action, claims 12-16 were rejected under 35 U.S.C. 112, second paragraph. The Examiner indicated that "Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL" (Office action paragraph no. 12).
5. Applicants here petition for withdrawal of finality of the Office action.

**Points to be Reviewed**

In the Office action dated September 24, 2003, the Examiner indicates that the "new grounds of rejection" of claims 12-15 under 35 U.S.C. 112, second paragraph, was necessitated by the amendments, and on that basis has made the action final (Office action paragraph no. 14). However, in the first Office action of April 10, 2003, the Examiner failed to examine or even acknowledge original claims 15 and 16, a point Applicants noted in the Amendment dated July 10, 2003.

Therefore, the present Office action represents the **first examination** of original claims 15 and 16. Accordingly, the rejection of claim 15 and 16 in the present Office action is not a “**new** grounds of rejection”, but rather the **first** rejection of these original claims. As such, it is improper that this be a final Office action. Whether the rejection of claims 15 and 16 under 35 U.S.C. 112, second paragraph, was necessitated by the amendment of July 10, 2003, is immaterial to the issue of finality of the Office action.

#### **Action requested**

Applicants request withdrawal of the finality of the outstanding Office action of September 24, 2003. Accordingly, applicants request either:

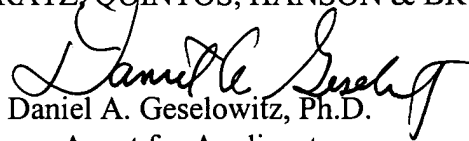
- a) A new Office action repeating the Office action of September 24, 2003, but being non-final; or
- b) That Applicants’ response to the outstanding Office action be treated as a response under 37 CFR 1.111 to a non-final Office action, rather than as a response to a final Office action.

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It is believed that this Petition is timely filed within two months of the Office action of September 24, 2003, and that no fee is required. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP



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